REMARKS

Claims 1-50 are pending in this application. Of these pending claims, Claims 1-15, 26-46, 49 and 50 stand rejected and Claims 16-25, 47, and 48 stand withdrawn.

The foregoing amendments and following remarks are believed to be fully responsive to the outstanding office action, and are believed to place the application in condition for allowance.

Response to Arguments

In paragraph 6 (page 14) of the pending office action, it states that Applicants' arguments with respect to Claims 1-15, 26-46, 49, and 50 have been considered but are moot in view of the new ground(s) of rejection. Applicants have carefully reviewed the pending office action and are of the opinion that the ground(s) of rejection are not new. Applicants believe that the ground(s) of rejection described in the pending office action are identical to the ground(s) of rejection described in the final office action mailed 11 February 2004. As such, Applicants are resubmitting the claim amendments and arguments originally presented in their RCE mailed 11 May 2004 and ask that the Examiner consider both.

Applicants are also proceeding under the assumption that a subsequent office action, if a subsequent office action is deemed necessary by the Examiner, will be a non-final office action for the reasons described in the preceding paragraph. If this assumption is incorrect, the Examiner is invited to contact Applicants' representative prior to the mailing of a subsequent office action.

Claim Rejections – 35 U.S.C. § 103

Claims 1-4, 6, 10-12, 26-36, 39-40, and 44-46 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Sievers, et al. ('441) reference in view of the Coulter ('949) reference. Currently pending Claims 5, 37 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Sievers, et al. ('441) reference in view of Coulter ('949) reference, as applied to claims 1-4, 6, 10-12, 26-36, 39-40 and 44-46, and further in view of the Matsumoto et al. ('456) reference. Claims 7, 8, 41, and 42 stand rejected under 35 U.S.C. §103(a)

as being unpatentable over the Sievers, et al. ('441) reference in view of the Coulter ('949) reference, as applied to claims 1-4, 6, 10-12, 26-36, 39-40, and 44-46 and further in view of the Shrivastava et al. ('401) reference. Claims 9 and 43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the ('949) reference in view of the Sievers, et al. ('441) reference in view of the Coulter ('949) reference, as applied to claims 1-4, 6, 10-12, 26-36, 39-40, and 44-46, and further in view of the Ishikawa et al. ('347) reference. Claims 13-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Sievers et al. ('441) reference in view of the Coulter ('949) reference, as applied to claims 1-4, 6, 10-12, 26-36, 39-40, and 44-46, and further in view of the Wang ('980) reference.

Independent Claims 1 and 11 include the feature of the marking material being solvent free when it is mixed with the fluid to form the mixture of the fluid and the solvent free marking material, as described on at least page 10, line 4 through page 12, line 22 Applicants' specification. Applicants respectfully submit that the prior art cited above does not disclose this feature.

In this regard, Applicants submit that the Sievers et al. ('441) reference discloses a two step process for forming fine particles that includes first dissolving (or suspending) a substance in a first nongaseous fluid to form a first solution (or suspension), and then mixing the first solution (or suspension) with a second nongaseous fluid to form a composition having the first solution (or suspension) and the second nongaseous fluid (Abstract; Col. 4, lines 17-34; col. 4, line 61 – col. 5, line 7). As such, the substance, or marking material, disclosed in the Sievers et al. ('441) reference needs to be first dissolved or dispersed in a fluid which (referring to the fluid) is then suspended or dispersed in the supercritical fluid to form an aerosol (col. 4, lines 1-7).

In contrast, the marking material of Applicants' invention is solvent free prior to mixing with the fluid. In this context, the fluid of Applicants' invention is analogous to the second nongaseous fluid disclosed in the Sievers et al. ('441) reference. As such, Applicants' invention does not need to first dissolve (or suspend) the marking material in a first nongaseous fluid to form a first solution (or suspension) prior to mixing with the second nongaseous fluid. However, if additional surfactants, cosolvents, and/or dispersant material(s) are desired for a given application, the additional material(s) is added to the formulation

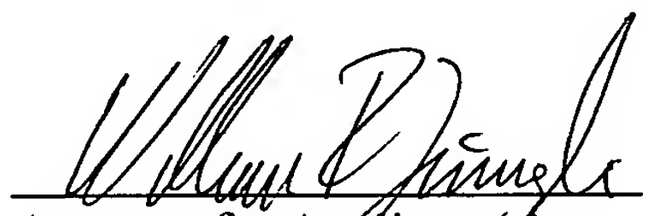
reservoir(s) with the marking material and the fluid, as described on at least page 11, lines 9-16 and page 11, line 24 through page 12, line 22. As such, when comparing Applicants' invention to the Sievers et al. ('441) reference, the mixing process of Applicants' invention can be thought of as a one step process. Claims 2-10, 12-15, 26-46, 49, and 50 depend from either Claim 1 or Claim 11. Accordingly, reconsideration and withdrawal of the 35 U.S.C. §103 rejection of Claims 1-15, 26-46, 49, and 50 is respectfully requested.

CONCLUSION

It is respectfully submitted that, in view of the above amendments and remarks, this application is now in condition for allowance, prompt notice of which is earnestly solicited.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,



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